



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,159	12/04/2001	Yukio Nakanishi	1131-0459P	8243

2292 7590 04/17/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
----------	--------------

1731

9

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/000,159

Applicant(s)

NAKANISHI ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the Written Restriction in Paper No. 7 is acknowledged. The traversal is on the ground(s) that a serious burden has not been placed on the Examiner to consider all of the claims in a single Application because a different field of search does not really exist since, Applicant asserts, a review of the subject matter set forth in claims 1-21 would include a review of both subclasses 131/347 and 131/370, in which the inventions are classed. This is not found to be persuasive. The Examiner contends that the inventions are distinct based on the reasons stated in the written restriction. Further, just because examination of all the claims may include a search in the above subclasses doesn't mean that the field of search for those claims would be the same as that of the distinct inventions. Each of the inventions require different searches since they are drawn to different statutory classes; therefore, as stated in the written restriction, the search for Invention I is not required for the search of Invention II, etc.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on June 4th, 1999. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1731

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3,5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 3,5 and 7 recite the limitation "said cover layer". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graves, Jr. (US. Pat. No. 4,768,527).

Graves, Jr. discloses a smokable sheet-like material having multi-layer structure with alternating layers of filler material. The word "multi-layer" refers to two or more layers, so obviously the sheet disclosed in Graves, Jr. includes either a two-layer or three-layer sheet. Adhesion between the various layers is provided by binding agents which may be present in the filler materials. The adjacent layers are composed of diverse materials and can have an ABA or ABC configuration. Tobacco material useful in its invention include tobacco fines, tobacco dust, tobacco laminae, tobacco stems, etc. Therefore, the Graves, Jr. disclosure encompasses a two-layer sheet having as a base/carrier layer fibrous tobacco stems (corresponding to the claimed "non woven

Art Unit: 1731

plant fibers”), and as a tobacco powder layer a mixture of tobacco dust/fines and starch (as binding agent), up to 10%.

Regarding claim 2, also encompassed by the Graves, Jr. disclosure is a three-layer ABA-configured sheet wherein tobacco dust/fines comprise the center layer, and the adjacent layers (one of which corresponds to the claimed “cover layer”) are provided from a fibrous tobacco stem containing material.

Regarding claim 3, it differs from the Graves, Jr. reference because of the basis weight parameters stated; however, this language is not deemed to impart any patentable distinction from the applied reference since “basis weight” is merely one of many known sheet parameters that can be selected, after routine experimentation, to provide optimal performance of the final product.

Regarding claim 6, Graves, Jr. mentions starch as a suitable binder, and it would have been obvious to one having ordinary skill in the art to utilize cornstarch since this is a conventionally used type of starch that is readily and widely available.

Regarding claim 7, also encompassed by the Graves, Jr. disclosure is a three-layer ABC-configured sheet having a first layer of tobacco dust/fines/binder, a second layer of tobacco cut filler/scrap of stems/leaves, and a third layer fibrous tobacco stem containing material.

Conclusion

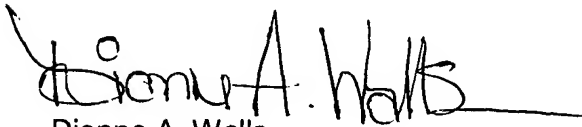
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.


Dionne A. Walls
April 15, 2003